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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Before the Board of Patent Appeals and Interferences

In re the Application

Inventor : **Stephen Johnson *et al***
Application No. : **09/804,074**
Filed : **March 13, 2001**
For : **A SYSTEM AND PROCESS FOR NETWORK
COLLABORATION THROUGH EMBEDDED
ANNOTATION AND RENDERING INSTURCTIONS**

REPLY BRIEF

On Appeal from Group Art Unit 2154

**In Response to Examiner's Answer Dated April 29, 2008 and
Supplemental Answer Mailed by the Examiner on May 8, 2008**

**Stephen Gigante
Reg. No. 42,576**

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Attorney for Appellant

In response to the Examiner's Answer mailed April 29, 2008 and Supplemental Answer mailed May 8, 2008, Appellant respectfully replies as follows:

I. Appellant notes the although the Examiner has cited a rejection of claim 23 on un-numbered page 4, paragraph number 3, of the Examiner's Answer, the Examiner has withdrawn the rejection of claim 23 under 35 U.S.C. §101, as noted in item "(10) Response to Argument" on un-numbered page 16.

II. With regard to the rejections of claims 17, 41 and 53 under 35 U.S.C. §101, Applicant strongly disagrees that the claims are directed to "software per se".

First, the Examiner has not properly set forth a ground of rejection under 35 U.S.C. §101 by alleging that "the language of the claims *raises a question* as to whether the claims are directed merely to an abstract idea that is not tied to a technological art... "Raises a question" is not a proper basis for a rejection under 35 United States Code. A rejection under 35 U.S.C. §101 should set forth with specificity why the claim(s) are being rejected, and not merely set forth that a question is raised and reject the claims "as detailed in MPEP 2106".

Second, none of the rejected claims recite "software per se", and with regard to claims 17 and 53, each of said claims respectively recites in part "a server process for receiving at least one generated collaborative content elements" (claim 17) and "a server process for responding to a user request" (claim 53).

Additionally, all of claims 17, 41 and 53 respectively recite in part a graphical collaboration tool. Claim 17 specifically recites "a graphical collaboration tool *for generating* at least one collaborative content element on the collaborative content *displayed* in said web browser software and *transmitting* the at least one collaborative

content element and rendering instructions therefore"; claim 41 recites in part "a graphical collaboration tool *for generating, rendering* said collaborative content in accordance with said rendering instructions, *and transmitting said collaborative content* with said rendering instructions embedded therein".

Appellant strongly disagrees with the Examiner's statement that "[T]hese functionalities do not manipulate any hardware or tangible entity" (un-numbered page 3 of the Examiner's Answer), and responds in kind, *infra*.

Appellant refers at least to FIG. 2, element 53, wherein the server process 53 comprises a server and a persistent a base document storage 55, as well as a transport mechanism 54 for a client workstation 50 to communicate with the server. Furthermore, page 13 of the present specification, at paragraphs [46] and [47] provides a detailed exemplary description of hardware for functional claim limitations including recited the server process 53.

Appellant respectfully remarks that under 35 U.S.C. 112, sixth paragraph, claim elements such as the server process can be recited in terms of function, and in claims 17 and 53, there is clearly more than abstract "software constructs" regarding the recited "server process for ...", as well as the recited "collaboration tool for ..." in claims 17, 41 and 53. Contrary to the Examiner's allegations, the claim language does in fact manipulate hardware and provides a tangible output.

For example, Appellant respectfully submits that a display of collaborative content created by a collaboration tool and viewed on a base document of a client workstation comprises a tangible output. Accordingly, said claims recite statutory subject matter under 35 U.S.C. §101.

Furthermore, Appellants strongly disagree exception with the Examiner's statement that the claims do not recite statutory subject matter because "[C]laims 17, 41 and 53 are directed to software (software per se) *not stored on a computer-readable media.*" (emphasis added in boldface by Appellant, please see Examiner's Answer on un-numbered page 17).

Appellant also notes that there is no *per se* requirement under 35 U.S.C. §101 regarding the recitation of "executable code on machine readable data". Appellant notes that a computer executing software is a special purpose computer, and in general such claims may be patentable due to the steps performed by the software when executed by the computer. Appellant also respectfully submits that the Computer Related Examination Guidelines issued by the USPTO: (1) are merely a tool to guide the Examiner; (2) are not statutory law or regulatory code; and (3) are not even required by the USPTO to be followed by the Examiner, as they are merely instructive.

Moreover, with regard to a recent decision (March 28,2008) by the Court of Appeals for the Federal Circuit in *Aristocrat Technologies Australia (ATA) PTY Limited and Aristocrat Technologies, Inc. v. International Gaming Technology (IGT)* (2007-1419) (Fed. Cir. 2008), Appellant respectfully submits that FIGs. 5, 6, 7 and 8 and the discussion in the specification at least at page 16, paragraph [54] to page 19, paragraph [64] provide an algorithm with specific examples in URL, HTML and XML formats to transform a general purpose computer into a special purpose computer programmed to perform the disclosed algorithm (*ATA v. IGT* at pages 16-17 referring to *WMS Gaming, Inc. v. International Game Technology*, 184 F.3d 1339 at 1349) (Fed. Cir. 1999).

Accordingly, Appellant respectfully submits that all of the claims recite statutory subject matter in compliance with 35 U.S.C. §101, as the claims recite a special purpose computer programmed to perform disclosed algorithm, and are not merely software constructs *per se* as alleged by the Examiner.

For at least the above reasons, Appellant respectfully requests to the Honorable Board of Appeals and Interferences that all grounds of rejection under 35 U.S.C. §101 be reversed.

III. With regard to the rejection of claims 1-14 and 16-65 under 35 U.S.C. §102(e) in view of Rivette *et al.* (U.S. 6,877,137) ("Rivette"), Appellant respectfully reiterates that Rivette fails to disclose that a base document is annotated by an encoded representation of the collaborative content and rendering instructions embedded into the identifier of the base document. Appellant respectfully submits that the Examiner is disregarding the claim language of "so as to annotate a base document by embedding said at least one annotation and instructions therefore as an encoded representation of collaborative content..." as recited, for example, in claim 1, and similarly recited in claims 17, 23, 41 and 53.

With regard to Rivette, Appellant respectfully submits that while the Rivette reference provides a link to a document, such as an additional note or notes that can be viewed by clicking on a linking button (which may use OLE), the claim language recited in the present claims recites (for example, HTML code) that the *actual annotation and the rendering instructions are embedded into the document identifier*. In other words, *whereas Rivette discloses a link(s) to see other notes posted to an application, the*

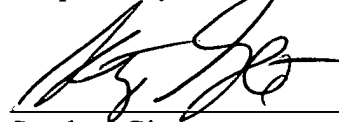
claimed invention is reciting that the annotation and the rendering instructions to process are embedded into the document identifier of the base document.

Thus, for at least the aforementioned reasons, none of the present claims are anticipated by Rivette. Nor would any of the present claims have been obvious in view of Rivette at the time of invention, nor would the combination of elements as recited in the claims have been obvious to a person of ordinary skill in the art at the time of invention as being within the ordinary level of skill in the art (*KSR International v. Teleflex*, 127 S.Ct. 1727, 82 USPQ2d 1385 (2007)).

CONCLUSION

In view of the above reply, Appellant respectfully requests that the Honorable Board of Patent Appeals and Interferences reverse all grounds of rejection in the Final Office Action of June 27, 2007.

Respectfully submitted,



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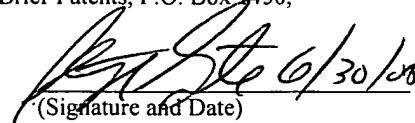
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